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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,815	12/06/2000	Daniel Newman	2717.100	9252
5514 7590 12/12/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER HEWITT II, CALVIN L	
			ART UNIT 3621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/729,815

Applicant(s)

NEWMAN, DANIEL

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-22, 25-27, 30, 32, 33, 36-58, 61 and 66-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-22, 25-27, 30, 32, 33, 36-37, 38-45, 46-53, 54-58, 61, and 66-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-5, 7-22, 25-27, 30, 32, 33, 36-37, 38-45, 46-53, 54-58, 61, and 66-77 have been examined.

Claim 6 was cancelled by Applicant; therefore, as claims 24 and 31 depend from claim 6 there are also considered cancelled.

Response to Amendments/Arguments

2. Applicant is of the opinion that the prior art of Ginter et al. do not teach billing an account (e.g. credit card account) apart from the account held at the billing server. The Examiner respectfully disagrees. Initially, however, the Examiner would like to direct Applicant to the scope of claim 5. Claim 5 recites "storing, at the third party billing server,... at least one of a credit card number and a debit card number *associated with an account held by the user, apart from the account established at the third part billing server*" (emphasis added). Therefore, in order to read on the above, a credit or debit card merely has to be used to make payments on an account different or apart from the account held at the billing server on which the credit or debit card number is currently stored. Hence, interpreting Applicant's billing server as a credit or debit card company continues to be valid. On the other hand, Ginter et al. also teach establishing an

account at a clearinghouse, receiving a customer's usage of content at the clearinghouse and the clearinghouse billing the customer's credit card or bank account in response to the usage data (column 315, lines 10-15; column/line 315/67-316/5; column 316, lines 48-58; column/line 316/67-327/8), as well as setting user defined spending parameters (figures 72C and D). In either case, the Examiner maintains the rejection.

Regarding the 112 rejection, the processes of claims 25, 26, 54, 56, 76 and 77 are not found in the embodiments depicted in claims 5 and 33 hence the operation of Applicant claimed method and system are unclear to one of ordinary skill.

In addition the Examiner would like to reiterate the following:

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP 2106 II C)

Hence, the Examiner's position is not derived from omitting certain limitations but that limitations which are expressed using language that doesn't require a step to be performed (e.g. limitations introduced using terms such as "when", "if", "may" or "can") *does not* further limit the claims, and therefore cannot be relied on to distinguish claims from the prior art. In addition, what a computer is "adapted for" (e.g. claim 33) also does not distinguish a claimed apparatus from a prior art apparatus as it is intended use (MPEP §2106 and 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-5, 7-22, 25-27, 30, 32, 33, 36-37, 38-45, 46-53, 54-58, 61, and 66-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1, 3, 33, 61, 66, 69, 70, 74 and 75, are directed to a system comprising where user defined parameters “are not used to perform a search for content”. However, it is not clear to one of ordinary skill how Applicant’s system can prevent a user from entering user defined parameters and then using the same parameters to query a database.

Claims 2, 4, 7-22, 25-27, 30, 32, 34-58, 61, 67, 68, 72, 73, 76 and 77 are also rejected as each depends from either claim 1, 3, 33, 61, 66, 69, 70, 74 and 75.

b. Claims 25, 26, 54, 56, 76 and 77 recite storing user-preferences at a remote location. Claims 5 and 33, from which the above claims depend, recite

storing user-preferences at a user computer. According to the Specification (page/line 39/17-38/7) these embodiments of Applicant's system are mutually exclusive therefore the operation of claims 25, 26, 54, 56, 76 and 77 are unclear to one of ordinary skill (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7-22, 24, 27, 30-33, 36-37, 39-44, 46-53, 57, 58, 61, and 66-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U.S. Patent No. 5,892,900 or over Ginter et al., U.S. Patent No. 5,892,900 in view of Krishnan et al., U.S. Patent No. 6,073,124.

As per claims 1-20, 22-24, 27-44, 46-52, 57-59, 61, and 66-77, Ginter et al. teach a method and system for receiving fee-based content over the internet (figure 84) comprising:

- setting and storing user-defined parameters at a user appliance specified by the user to accept all fees below a pre-determined

amount, the amount defining a threshold for determining whether an individual fee should be accepted without regard to a cumulative total of the fees and wherein the parameters are not used to search for content (figures 72 B and C, column/line 263/54-264/16)

- the user appliance receiving a selection of content from any content provider (figures 72A-D and 84) comparing the fee for the selected content to the predetermined amount and displaying the selected content when the fee is less than the predetermined amount (column 9, lines 19-24; column/line 263/54-264/16)
- prompting a user for acceptance of a fee when the fee for selected content exceeds the predetermined amount (column 264, lines 5-16)
- integrating the at least one predefined user preference on a browser application (figures 72A-D; column 263, lines 37-48; column 264, lines 4-16 and 27-42)
- user defined parameters that pre-authorizes (e.g. a signal such as allowing users to access content without prompting the user) payment for a quantity of fees within a particular time period, for individual fees that do not exceed a threshold, for accumulated fees that do not exceed a threshold, rejects content that exceeds a

predetermined or accumulated amount (column 263, lines 38-61;
column 264, lines 12-16)

- collecting content from a plurality of content providers as a function of HTML (figures 72A-D and 79-84)
- inputting a user defined password prior to requesting content over a network (figure 72A)
- obtaining a first portion without a fee (column 263, lines 25-38), determining whether a second portion is desired (figures 72A-D; column 263, lines 25-38) wherein acceptance is based on user defined parameters (column/line 263/54-264/16)
- paying royalties (column 281, lines 20-44)
- applying different user parameters for different content (column 291, lines 5-28)

Ginter et al. also teach transforming a PC into a secure VDE device by delivering VDE software to a user for installation (figure 69A; column 60, lines 15-17; column 64, lines 8-15; column/line 86/63-87/8; column 87, lines 31-39; column 226, lines 30-54) and running the software within a browser (figure 72D); column 264, lines 27-42).

Regarding third party providers (e.g. credit card company, financial institutions) and accumulating a plurality of fees, Ginter et al. disclose a user paying for content using a credit or debit card (e.g. VISA) (column/line 290/60-

291/16), hence Ginter et al. discloses third party providers that accumulate fees, a user making payments and overpayments (e.g. claim 48) to a third party provider, individual and accumulated fee thresholds, and said provider accumulating user charges, verifying fees, billing a user, storing user account and paying a content provider on behalf of a user. Ginter et al. teach using electronic currency for obtaining content (column 41, lines 15-20). Therefore Ginter et al. teach paying fees to a content provider in a first currency and to a third party provider (e.g. another user) in a second. Ginter et al. also teach programmable smart objects that search remote computer systems for specific content based on user search parameters (column 264, lines 52-57; column 265, lines 20-38; column 266, lines 22-38). Specifically, Ginter et al. teach software objects governed by "at least one rule and/or control associated with the software agent that governs the agent's operation". Hence, an obvious application of Ginter et al. is for creating a software object that only retrieves content from TimeWarner intellectual property sites (figure 72D) and apply budget constraints such as a spending maximum of 15 US dollars (column 266, lines 27-39). Ginter et al. also teach limiting a child's VISA budget to video game related content while not limiting the child's access to encyclopedia content (column 291, lines 6-29). Regarding fees that exceed a predetermined amount, messages from third party providers to users indicating "insufficient funds" or "overdrawn" are old and

well-known, hence it would have been obvious to inform a user if he/she lacks the credit to obtain desired content.

As per claim 21, it is well-known that companies such as Comcast, Verizon, Bell South, MSN and AOL charge fees for accessing the internet. Therefore, "internet access" is "at least some of the fees" that a user accumulates for making purchases online (see also Ginter et al., column 266, lines 33-35).

As per claim 53, in order to connect to the internet a content company pays a fee to an internet service provider such as Verizon, Comcast or Bell South, hence a credit card company [payment appliance for authorizing transactions over the internet] is associated with an ISP.

As per claims 1-5, 7-22, 24, 27, 30-33, 36-37, 39-44, 46-53, 57, 58, 61, and 66-77, Ginter et al. teach credit and debit cards embodied as electronic wallets (column/line 40/62-41/23). Krishnan et al. teach electronic wallets stored on a user computer and using said wallet to purchase content (figures 12 and 14-18; column/line 20/54-21/21). Electronic wallets as browser plug-ins are old and well known. Therefore, it would have been obvious to combine the teachings Ginter et al. and Krishnan et al. in order allow a user to better keep track of the electronic wallet (see also *In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961)).

7. Claims 25, 26, 54, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U.S. Patent No. 5,892,900 in view of Daly et al., U.S. Patent No. 5,878,141 or over Ginter et al., U.S. Patent No. 5,892,900 and Krishnan et al., U.S. Patent No. 6,073,124, as applied to claims 5 and 33 above, and in further view of Daly et al., U.S. Patent No. 5,878,141.

As per claims 25, 26, 54 and 56, Ginter et al. teach a user customizing a credit card (e.g. VISA) for making purchases over the internet (column 263, lines 54-61; column 267, lines 3-5; column/line 290/32-291/30). However, Ginter et al. do not specifically teach customizing use of a credit card at a remote third party site. Daly et al. teach a user accessing a third party provider terminal for establishing and storing user preferences associated with customizing the use of a credit card (figures 1 and 5; column 6, lines 3-36; column 17, lines 17-47). Daly et al. also teach storing the preferences at the third party, user terminal or simultaneously on both (column 7, lines 25-40). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Ginter et al. and Daly et al. in order to more efficiently match customer payment methods with that of a service provider ('141, column 7, lines 33-48; '900, column 184, lines 62-67).

8. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U.S. Patent No., 5,892,900 in view of Langhans et al., U.S. Patent

No. 5,500,513 or over Ginter et al., U.S. Patent No. 5,892,900 and Krishnan et al., U.S. Patent No. 6,073,124, as applied to claim 33 above, and in further view of Langhans et al., U.S. Patent No. 5,500,513.

As per claim 38, Ginter et al. teach a user establishing spending limits (column/line 263/48-264/15). However, Ginter et al. do not explicitly recite accepting a preselected number of fees. Langhans et al. teach a system for controlling credit card purchases based on spending parameters (abstract; figures 5-7, 10 and 11; column/line 14/55-16/16) such as the number of charges over a preselected period of time (column 11, lines 35-63; column 13, lines 25-46). Langhans et al. also teach overrides (column 9, lines 15-21). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Ginter et al. and Langhans et al. in order provide improved fraud detection ('513, column 1, lines 47-6)

9. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U.S. Patent No. 5,892,900 in view of Casement et al., U.S. Patent No. 5,969,748 or over Ginter et al., U.S. Patent No. 5,892,900 and Krishnan et al., U.S. Patent No. 6,073,124, as applied to claim 33 above, and in further view of Casement et al., U.S. Patent No. 5,969,748.

As per claim 45, Ginter et al. teach spending limits for obtaining content (column/line 263/54-264/16). However, Ginter et al. do not specifically recite a

password for obtaining content that exceeds a spending limit. Casement et al. also recite prompting a user for acceptance of charges that exceed the predetermined spending limit (figure 5; column 5, lines 40-51) and limiting access to predetermined content providers and restricting access to content based on content type (figures 2C-E). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Ginter et al. and Casement et al. in order to provide a user with more control and choices over how he/she is to use his/her a budget. For example, a family can share a single wallet or account and spending controls can be applied to the children while more responsible members (i.e. parents) are able to use the card more freely ('900, column/line 290/60-291/16; '748, figure 5; column 5, lines 40-51).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

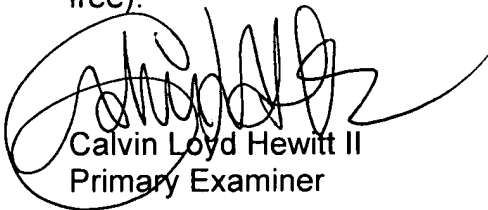
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Application/Control Number:
09/729,815
Art Unit: 3621

Page 13

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free).



Calvin Loyd Hewitt II
Primary Examiner

December 7, 2007